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10/808,886

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Eric O. Bodnar

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08/03/2006

EXAMINER

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ART UNIT

PAPER NUMBER

2614

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/808,886

Applicant(s)

BODNAR ET AL

Examiner

Md S. Elahee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,5-8 and 10-16 is/are rejected.
- 7) ☒ Claim(s) 3,4,9 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. This action is responsive to an amendment filed 05/19/2006. Claims 1-16 are pending. Claims 3, 4 and 9 have been previously objected. Claim 17 has been previously withdrawn from consideration.

Response to Arguments

2. Applicant's arguments mailed on 05/19/2006 Remarks regarding claims 1,2,5-8 have been fully considered but are moot in view of the new ground(s) of rejection which is deemed appropriate to address all of the needs at this time

3. Applicant's arguments mailed on 05/19/2006 Remarks regarding claims 10-16 have been fully considered but they are not persuasive.

Regarding claim 10, the applicant argues on page 9 that **Ala-Laurila** not only fails to teach or suggest a multi-media messaging center (MMSC), but also fails to teach or suggest “a response directed to an MMSC in response to a notification/message by a third party originator”. Examiner respectfully disagrees with this argument. **Ala-Laurila** discloses a server (fig.1, item 30) including a network message storage for providing storage of voice and text messages which are multimedia messages (col.3, lines 13-16). Therefore, the server is the claimed multi-media messaging center (MMSC). **Ala-Laurila** further discloses after receiving the voice or text message, the intended recipients are alerted/notified about the message and in response to the notification the recipient uses phone number to access the server (fig.1,2; col.4, lines 18-46). This “access” is the claimed response. Therefore, it is clear that **Ala-Laurila** not only teaches a

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multi-media messaging center (MMSC), but also teaches a response directed to an MMSC in response to a notification/message by a third party originator. Thus, the rejection of the claim will remain.

Allowable Subject Matter

4. Claims 3, 4 and 9 have been already objected in the previous office action.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 10, 11 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by **Ala-Laurila** (U.S. Patent No. 6,246,871).

Regarding claim 10, **Ala-Laurila** teaches a system comprising:

a message handler to ensure that a response directed to a server 30 [i.e., multi-media messaging service center (MMSC)] in response to a notification/message by a short message service (SMS) [i.e., third party originator] to a recipient are managed without triggering error messages inherently in the MMSC (abstract; fig.1; col.2, lines 15-24, 60-67, col.3, lines 17-30, col.4, lines 16-32).

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Regarding claim 11, **Ala-Laurila** teaches a message database selector 32 [i.e., message handler] is part of the server [i.e., MMSC] (fig.1).

Regarding claim 16, **Ala-Laurila** teaches a message ID spoofer to select a message ID which indicates to the MMSC that the third party originator sent a notification/message to the recipient (fig.1; col.3, lines 17-30, 61-67, col.4, lines 1-9). (Note; message ID spoofer is an inherent for the message database selector 32 [i.e., message handler])

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any

evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims 1 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Ala-Laurila** (U.S. Patent No. 6,246,871) in view of **Chen et al.** (U.S. Patent No. 5,751,791).

Regarding claim 1, with respect to Figures 1,2 **Ala-Laurila** teaches a system comprising:
a short message service (SMS) [i.e., third party originator] to send a notification/message of a voice and/or text message to a recipient without the use of a server 30 [i.e., multi-media messaging service center (MMSC)] (abstract; fig.1; col.2, lines 15-24, 60-67, col.3, lines 13-16, col.4, lines 16-32); and

a message database selector 32 [i.e., message handler] to manage the responses sent by the recipient to the server (fig.1; col.3, lines 17-30).

However, **Ala-Laurila** does not specifically teach “send a notification/message of a multimedia message”. **Chen** teaches send a notification/message of a multimedia message (abstract; fig.5; col.8, lines 47-53). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify **Ala-Laurila** to incorporate a proxy server to redirect responses sent by the recipient to the MMSC as taught by **Chen**. The motivation for the modification is to do so in order to provide a particular notification to an intended multimedia message recipient.

Regarding claim 7, **Ala-Laurila** teaches a message ID spoofer to select a message ID for the notification/message sent by the third party originator that will be handled by the MMSC (fig.1; col.3, lines 17-30, 61-67, col.4, lines 1-9). (Note; message ID spoofer is an inherent for the message database selector 32 [i.e., message handler])

11. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Ala-Laurila** (U.S. Patent No. 6,246,871) in view of **Chen** et al. (U.S. Patent No. 5,751,791) further in view of **Chan** et al. (U.S. Pub. No. 2004/0123144).

Regarding claim 2, **Ala-Laurila** in view of **Chen** does not specifically teach “a proxy server to redirect responses sent by the recipient to the MMSC”. **Chan** teaches a proxy server to redirect responses sent by the recipient to the MMSC (fig.4; page 6, paragraph 0062). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify **Ala-Laurila** in view of **Chen** to incorporate a proxy server to redirect responses sent by the recipient to the MMSC as taught by **Chan**. The motivation for the modification is to do so in order to act as an intermediate agent between user and back-end application.

12. Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Ala-Laurila** et al. (U.S. Patent No. 6,246,871) in view of **Chen** et al. (U.S. Patent No. 5,751,791) further in view of **Middleton, III** et al. (U.S. Patent No. 6,393,407).

Regarding claim 5, **Ala-Laurila** in view of **Chen** fails to teach “a dummy message inserter to insert a dummy message into the MMSC, such that the MMSC accepts the response sent by the recipient to the MMSC”. **Middleton** teaches a dummy message inserter to insert a dummy message into the MMSC, such that the MMSC accepts the response sent by the recipient to the MMSC (fig.2; col.5, lines 54-65). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify **Ala-Laurila** in view of **Chen** to incorporate a dummy message inserter to insert a dummy message into the MMSC, such that the MMSC accepts the response sent by the recipient to the MMSC as taught by **Middleton**. The motivation for the modification is to provide the user an option to leave web page in the server.

Regarding claim 6, **Ala-Laurila** teaches that the responses are sent by the recipient to the MMSC (fig.1; col.3, lines 17-30). However, **Ala-Laurila** in view of **Chen** fails to teach “the responses sent by the recipient to the MMSC, as indicated by the dummy message inserter”. **Middleton** teaches the responses sent by the recipient to the server [i.e., MMSC], as indicated by the dummy message inserter (fig.2; col.5, lines 54-65). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify **Ala-Laurila** in view of **Chen** to incorporate the responses sent by the recipient to the MMSC, as indicated by the dummy message inserter as taught by **Middleton**. The motivation for the modification is to provide the user an option to leave web page in the server.

13. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Ala-Laurila** (U.S. Patent No. 6,246,871) in view of **Chan** et al. (U.S. Pub. No. 2004/0123144).

Regarding claim 12, **Ala-Laurila** does not specifically teach “the message handler is a separate proxy server”. **Chan** teaches the message handler is a separate proxy server (fig.4; page 6, paragraph 0062). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify **Ala-Laurila** to incorporate the message handler being a separate proxy server as taught by **Chan**. The motivation for the modification is to do so in order to act as an intermediate agent between user and back-end application.

14. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Ala-Laurila** (U.S. Patent No. 6,246,871) in view of **Perkowski** (U.S. Pub. No. 2002/0169687).

Regarding claim 15, **Ala-Laurila** fails to teach “a dummy message inserter to notify the MMSC that a notification/message has been sent directly to the recipient”. **Perkowski** teaches a dummy message inserter to notify the MMSC that a notification/message has been sent directly to the recipient (page16, paragraph 0160). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify **Ala-Laurila** to incorporate a dummy message inserter to notify the MMSC that a notification/message has been sent directly to the recipient as taught by **Perkowski**. The motivation for the modification is to track the status of messages.

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Timmins (U.S. 2005/0074112) teach Technique for sharing information through an information assistance service, and

Tripathy et al. (U.S. 2004/0121761) teach Method and apparatus for processing voicemail messages.

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Md S. Elahee whose telephone number is (571) 272-7536. The examiner can normally be reached on Mon to Fri from 8:30am to 5:00pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

M.E.

MD SHAFIUL ALAM ELAHEE

July 30, 2006


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